

**CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 CFR 1.8**

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 Karen L. Lum

(Signature)

August 21, 2009

(Date of Signature)

**RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3714**  
Due Date: August 27, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Shahla C. Cisneros et al.	Examiner:	HARPER , Tramar Yong
Serial No.:	10/687,474	Group Art Unit:	3714
Filed:	October 14, 2003	Docket No.:	PD-203019
		Confirmation No.:	8877
Title:	TELEVISION INTERACTIVE GAMING HAVING LOCAL STORAGE OF GAME PORTAL		

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**PRE-APPEAL BRIEF REMARKS**

MAIL STOP AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

In response to the Final Office Action dated 27 May 2009, and in conjunction with the filing of a Notice of Appeal, please consider the following remarks. Applicants reserve the right to present additional arguments during appeal and prosecution of the present application.

**Rejections**

In the Office Action, claims 1 and 8 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 2, 8, and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over NTN in view of Junkin, U.S. Patent No. 6,193,610, and further in view of Allen, USPA 2002/0119824. Claims 3 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over NTN, Junkin, Allen, and Crockett, USPA 2004/0039631. Claims 4-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over NTN, Junkin, Allen, and Walker.

Applicants note that claims 9-12 were not specifically rejected in the Office Action of 27 May 2009. However, Applicants will respond herein notwithstanding the lack of rejection of claims 9-12.

Applicants respectfully traverse and appeal the rejections listed in the Office Action.

#### Discussion

Applicants repeat and incorporate by reference herein the arguments made in the response to the Office Action, specifically pages 7-17 of Applicants' response of 13 February 2009.

#### Response to the 35 USC 112 Rejection

The Office Action states that the specification does not explicitly disclose initiating a game from the gaming application at a time other than a time of transmission of the gaming application.

Applicants traverse and appeal this rejection.

"Participants may compete in a particular game at any time.... Each new set of questions may give rise to a new contest between the participants." Specification, [008].

"The gaming system transmits data from the question database 12 and the trivia application 14 to a real-time update server 16. The update server 16 transmits data to an uplink server 18 that relays the data to a satellite 20. The satellite 20 then transmits the data from the question database 12 and/or game application 14 to a user's television STB 22. The questions and gaming application for playing the trivia game reside in the user's STB 22. The user may then interactively review the questions and provide answers via the STB 22." Specification, [030] (Cited in Office Action).

On pages 11-12, the Office Action admits that if the specification indicated that "at any time after the questions are stored on the STB that the player can answer the question that would be sufficient disclosure for initiating the game at a time other than transmission." Applicants respectfully submit that the specification in at least paragraphs [008] and [030] indicates exactly that: once the questions and gaming application are resident in the STB, the user may then interactively review the questions and provide answers via the STB. Thus, the specification must teach "playing the game other than at a time of transmission of the gaming application" as admitted as acceptable in the Office Action and the rejection should be withdrawn.

Applicants also traverse the Office Action's assertion that a game cannot be played while it is being transmitted. Applicants have consistently stated that game play in NTN occurs during

transmission of the NTN contest. NTN transmits, e.g., a live sporting contest along with additional question data such as “will the first play be a pass or a run?” which requires an answer prior to the first event of the game happening in real-time. Thus, NTN teaches a game that is being played while it is being transmitted.

Response to the Arguments in the Office Action

The Office Action admits that NTN’s tournament is held in real-time, and that such a tournament can extend for a long period of time, e.g., a week, etc. Applicant agrees with this characterization of NTN.

Taking the Office Action’s NTN characterization into account, and because NTN is a real-time, “live” broadcast of a game (i.e., a broadcast channel with interactive capability), if a NTN tournament were to last a week, any participant that started to compete two days after the week-long tournament started could not compete on those portions of the tournament that occurred during the first two days. In an NTN-based scenario such as presented in the Office Action, “real-time” must mean “instantly” and “only from this point forward” as well as “at the same time as transmission” of the gaming application/questions. The NTN reference merely teaches a live broadcast of an interactive game, much like any other broadcast channel broadcasts a show. If a viewer misses the first half of a live broadcast, the viewer cannot go back and start the show wherever they want to; that viewer only gets to view the live broadcast from the time that they tuned into that live broadcast in a causal fashion.

The present invention suffers from no such infirmity. The present invention allows a player to join the tournament after the tournament starts, complete the questions at their leisure, leave the tournament and return to the same place they left, and still answer those questions that were asked during the tournament prior to that particular user joining the competition or while that particular user was away from their STB or viewing other programming. In this sense, “other than a transmission time of the gaming application” becomes crucial, because NTN cannot and does not allow a user to play the game at any time other than the transmission time of the gaming application. NTN users must play the game as the game is going on, in real-time, i.e., as a live broadcast of the game, whether that broadcast lasts thirty minutes or one week. The present invention allows for a completely different scenario than that envisioned or suggested by NTN, because the present

invention allows a user to play the game at a time other than the transmission of the gaming application.

With the proper characterization of the NTN reference as a real-time broadcast of a trivia application played at the same time the trivia application is transmitted, no combination of NTN with any other reference renders the claims obvious because none of the references, including NTN, teach or suggest, and NTN teaches away from, playing the game at a time other than the time of transmission as recited in the claims of the present invention.

The arguments presented herein are supported by the specification as filed at least in paragraphs [008] – [011] and [025] – [034].

#### The References are Incompatible Under 35 U.S.C. § 103

To properly combine references, the references must be compatible with each other. Since NTN must be read as teaching a live broadcast having game play simultaneous with transmission, no reference in combination with NTN can change NTN to teach game play at a time other than transmission.

Further, since NTN teaches transmission simultaneous with game play, NTN is in conflict with any reference that teaches otherwise. Such a conflict renders combination of NTN with any such reference impossible as a matter of logic and as a matter of law. There can be no suggestion or teaching to combine references when the point of combination is directly incongruous. Further, no reference has been cited in any Office Action in the present application that teaches the limitations of the claims; even if such a reference had been cited, it cannot be compatible with NTN's teachings of the opposite conclusion.

Even if an ancillary reference can somehow be found or characterized as teaching otherwise, NTN's teachings are not merely modified, they are ignored completely. Thus, any such modification of NTN cannot be properly suggested when the references are in conflict. If anything, such a direct conflict suggests that modification of any of the cited references on the point of conflict is not possible, because the modification would then be a complete dismissal of the teachings of one of the references.

Thus, no reference can modify or be combined with NTN to selectively remove NTN's teaching that game play is simultaneous with transmission, because such a modification or combination is logically and legally inconsistent. Such references are, *de facto and de jure*, incompatible

with each other, because the references would teach opposing conclusions. There must be a suggestion to combine or modify the references, and the inconsistency and opposing nature of NTN with any such reference, and with the claims, on a specific issue is a direct suggestion not to combine or modify such references on the issue in conflict.

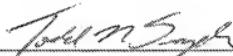
Claims 9-12 Are Not Rejected In The Office Action

Claims 9-12 are not specifically mentioned or rejected in the Office Action. Even if they had been mentioned or rejected, the above arguments also apply to claims 9-12, and claims 9-12 are even further removed from the cited references, because, again, both references do not discuss the limitations of claims 9-12. Therefore, claims 9-12 cannot be considered obvious in light of the combination of the references without a specific teaching to combine the references for the subject matter of the claims. The rejections must properly combine the references to teach the claims, and combination of the cited references is improper for these claims, not only because they are not rejected in the Office Action, but because the references are also in conflict with respect to these claims.

Conclusion

Thus, Applicants submit that claims 1, 2, 8, and 13 are allowable over NTN in view of Junkin and Allen, claims 3 and 14 are allowable over NTN, Junkin, Allen, and Crockett, and claims 4-7 and 9-12 are allowable over NTN, Junkin, Allen, and Walker.

Respectfully submitted,



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Date: August 21, 2009

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